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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,955	07/11/2001	Gabriel Stavros Panayi	78104.023	2246

7590 07/25/2003

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EXAMINER

ROARK, JESSICA H

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 07/25/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/806,955

Applicant(s)

PANAYI ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☒ Newly proposed or amended claim(s) 33,34,42 and 43 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 18,33,34,42,43 and 54.Claim(s) objected to: 24,47,50 and 53.Claim(s) rejected: 22,23,44-46,48,49,51 and 52.Claim(s) withdrawn from consideration: 30,32,40 and 41.

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PRIMARY EXAMINER
TAM LAM
7/24/03

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See Continuation Sheet

Continuation of 3. Applicant's reply has overcome the following rejection(s):

The rejection of record in Paper No 17 rejecting claims 22-24 and 44-53 under 35 USC 112, first paragraph has been obviated by Applicant's amendment.

Continuation of 5. does NOT place the application in condition for allowance because:

A) Claims 22-23 are rejected as being anticipated by Kozutsumi et al. (J. Cell. Sci. (supt) 1989; 11:115-137, of record).

Applicant's arguments, filed 3/14/03, have been fully considered but have not been found convincing because although Freund's adjuvant is not a pharmaceutically-acceptable carrier, PBS is, and the teachings of Kozutsumi et al. placing BiP(GRP78) in PBS were discussed in Section 20 of Paper No. 17.

B) Claims 44, 48 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by McGuire et al., (U.S. Patent 5,188,964, of record).

Applicant's arguments, filed 3/14/03, have been fully considered but have not been found convincing. Although Applicant argues that the '964 patent only mentions GRP78 in passing and that the kits are limited to other HSP and GRPs. However, the '964 patent clearly contemplates the inclusion of GRP78 along with the other HSP/GRPs described in detail, see for example column 9 at lines 28-39.

C) Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al., (U.S. Patent 5,188,964, of record).

Applicant's arguments, filed 3/14/03, are essentially the same as those discussed supra with respect the teachings of the '964 patent. As noted supra, these arguments have been fully considered but have not been found convincing because the '964 patent does contemplate GRP78 as part of the invention taught.

D) Claims 44, 45, 46, 49, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al., U.S. Patent 5,188,964, of record, in view of Hsu et al. (Protein Expression and Purification 1994; 5(6):595-603, of record), or Sambrook et al. (Molecular Cloning: A Laboratory Manual (1989) Cold Spring Harbor Laboratory Press, New York; page 17.2, of record).

Applicant's arguments, filed 3/14/03, have been fully considered but have not been found convincing.

Applicant's arguments with respect to the teachings of the '964 patent have been addressed supra.

Continuation of 10. Other:

A) Claims 34 and 43, previously withdrawn, have been rejoined in view of their amended dependency.

B) It is noted that this application is technically abandoned.